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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/005,347      | 12/07/2001  | Miwa Kozawa          | 100021-00065        | 8095             |

4372 7590 10/12/2005

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EXAMINER

PENG, KUO LIANG

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1712

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/005,347

**Applicant(s)**

KOZAWA ET AL.

**Examiner**

Kuo-Liang Peng

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/3/05 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-8 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-4 and 18-21 is/are allowed.
- 6) ☒ Claim(s) 5,6 and 8 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The Applicants' amendment filed on August 3, 2005 was received. Claims 1 and 9-17 are deleted. Claims 2 and 5 are amended. Now, Claims 2-8 and 18-21 are pending.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 052805) is/are removed.
3. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 052805).

#### ***Claim Rejections - 35 USC § 102***

4. Rejections of Claims 5-6 and 8 under 35 USC 102(b) as being anticipated by Miller (US 3 741 435) and, alternatively, Nishihara (JP 08-325276) are maintained because the rejections are adequately set forth in paragraphs 5-6 of Paper No. 052805. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

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For Applicants' argument (Remarks, page 7, 2<sup>nd</sup> paragraph from bottom), as mentioned in the previous Office action, Miller's or Nishihara's fillers of silica, silica gel, etc. are well known to contain  $\text{SiO}_{4/2}$  units. For example, Polmanteer (US 4 418 165) teaches that a silica filler contains  $\text{SiO}_{4/2}$  units. Note that Polmanteer is cited here merely to show the presence of  $\text{SiO}_{4/2}$  units in a silica filler.

5. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

None of Miller and Nishihara teaches or fairly suggests the specific  $\text{R}^8$  set forth in claim 7.

***Allowable Subject Matter***

6. Claims 2-4 and 18-21 are allowed.

7. The following is an examiner's statement of reasons for allowance:

The present claims are allowable for at least the following reason(s) over the closest references: Miller and Nishihara.

None of these references teaches or fairly suggests a) at least some of the X groups being triorganosilyl groups set forth in Claims 2-3; b) the polymer containing the units of  $O_{1/2}SiR^4R^5R^6$  having at least one organic group containing chloromethylphenylethyl set forth in Claims 4; and c) the polymer containing the units of both  $O_{1/2}SiR^1_2R^2COOH$  and  $O_{1/2}SiR^1_2R^2COOR^3$  set forth in Claims 18-21.


8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is

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(571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
October 3, 2005

  
Kuo-Liang Peng  
Primary Examiner  
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